

**REMARKS**

In response to the office action dated April 23, 2004, applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance. Claims 1-34 were rejected in the office action. Claims 1, 26, and 32 have been amended. Following entry of the present response, claims 1-34 will remain pending in the present application.

Applicant thanks Examiner Gauthier for agreeing to conduct a telephonic interview on July 20, 2004. Applicant thanks Examiner Gauthier for allowing applicant to discuss the nonobviousness of the present application in light of presently asserted art. Although agreement as to specific claim amendments was not reached, the discussion helped applicant provide further clarification of the invention in the present response along the lines discussed with Examiner Gauthier. Also, the discussion with Examiner Gauthier was helpful in facilitating and progressing the prosecution of the present application.

Claims 1-5, 7-8, 14-15, 24-28 and 32-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,787,151 to Nakatsu *et al.* (“Nakatsu”) in view of U.S. Patent No. 6,031,549 to Hayes-Roth (“Hayes-Roth”). Specifically, the office action suggests that, while Nakatsu fails to disclose a voice mail system “having a distinct mood,” Hayes-Roth teaches having a distinct mood. (Office Action date April 23, 2004 at p. 3). Moreover the office action’s rationale for combining the two references is that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personalized messages of Nakatsu by adding the current mood as taught by Hayes-Roth.” (*Id.*) Applicant has amended the present claims to further clarify the claim

terms and respectfully submits that the presently amended claims are patentable over Nakatsu in view of Hayes-Roth.

Independent claims 1, 26 and 32 have been amended to make explicit that which was previously implicit in the claims; namely that the user participates in an interactive inquiry to identify an agent and that, after identifying an agent, the identified agent and message is selected. Support for the presently amended claims may be found throughout the present specification, and particularly on page 13, lines 31-35 and page 14, lines 5-30.

Applicant submits that the amended claims are patentable over Nakatsu in view of Hayes-Roth. Hayes-Roth, entitled "System and Method for Directed Improvisation by Computer Controlled Characters," teaches "a computer system and method for directing the behavior of an improvisational character." (Hayes-Roth at col. 6, ll. 27-28). An improvisational character "is defined as any computer-controlled entity which is embodied in a computer-controllable medium such as computer graphics, animation, robotics, virtual reality, audio, video, film or text." (*Id.* at col. 6, ll. 30-34). The computer directs the behavior of the improvisational character by evaluating many factors including possible behaviors of a character, feasible behaviors of a character, directional state of a character, activity state of a character, current physical position of a character, location of a character in the physical world, and current mood of a character. (*Id.* at col. 3, ll. 44-53). The computer determines the relative desirability of each feasible behavior and then selects a behavior to be executed by the character based on a desirability rating. (*Id.* at col. 3, ll. 58-67).

Hayes-Roth does not teach presenting a user of a voice mail system with interactive inquiries to enable the user to identify the desired agent and to select an appropriate voice mail message. Furthermore, Hayes-Roth does not teach a telephone voice mail system or a

method for personalizing voice messages in such a system. Nakatsu discloses a telephone-based delivery system but does not teach a voice mail system having messages with distinct moods. Accordingly, applicant respectfully asserts that the combination of Hayes-Roth and Nakatsu is not, by itself, sufficient to establish a *prima facie* case of obviousness. M.P.E.P. § 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143. The office action argues that merely because the references can be modified, the combination of the references renders the instant claims obvious.

The office action has not pointed to any suggestion in the prior art regarding a desirability to modify and combine the references. The office action states that it would have been obvious to modify Nakatsu by adding the current mood as taught by Hayes-Roth because the “modification will allow the system to use of having a distinct mood such that the combination would provide possible physical and verbal behaviors to the messages.” (Office Action of 23 April, 2004 at p. 3). The office action does not explain where or if the quoted statement is suggested by the prior art. Therefore should the Examiner choose to maintain this rejection, applicant respectfully requests an explicit citation as to where it is suggested in Nakatsu or Hayes-Roth that it would be desirable to modify Nakatsu by combining it with Hayes-Roth as the office action has proposed.

Applicant asserts that without support in any prior art for the desirability to combine Nakatsu and Hayes-Roth, the office action’s assertion of obviousness amounts to nothing more than impermissible hindsight using the applicant’s present invention. While assuming that impermissible hindsight reconstruction may lead to such a construction, 35 U.S.C. § 103

requires a higher standard. 35 U.S.C. § 103 requires a specific suggestion or motivation suggested in the prior art to modify the reference or to combine reference teachings. MPEP 2143. Neither Nakatsu nor Hayes-Roth provide specific guidance that would lead one of ordinary skill in the art to combine the references and obtain the present invention. Specifically, Hayes-Roth teaches automatically generating a behavior for a computer-controlled character in which one input factor that the computer evaluates in determining output behavior of the character is the mood of the character. Hayes-Roth does not teach a telephone voice mail system. Hayes-Roth does not teach a method for personalizing voice messages in such a system. Hayes-Roth does not even mention the term “voice-mail.” Likewise, Nakatsu does not teach or suggest a computer system or a method for directing the behavior of computer-created, improvisational characters.

Accordingly, applicant respectfully requests withdrawal of the rejection of claims 1-5, 7-8, 14-15, 24-28 and 32-34 under 35 U.S.C. §103 (a) over Nakatsu in view of Hayes-Roth.

In addition, claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth and U.S. Patent No. 4,850,005 to Hashimoto (“Hashimoto”). Also, claims 9-11 and 29-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth and U.S. Patent No. 6,005,928 to Johnson (“Johnson”). Claims 12-13 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth, Hashimoto, and Johnson. Claims 16-17 and 22-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth and U.S. Patent No. 4,785,473 to Pfeiffer *et al.* (“Pfeiffer”). Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth, Pfeiffer and U.S. Patent No. 5,905,774 to Tatchell *et al.* (“Tatchell”). Claims 19-20 stand rejected under 35

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U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth, Pfeiffer and U.S. Patent No. 5,825,871 to Mark ("Mark"). Finally, claim 21 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatsu in view of Hayes-Roth, Pfeiffer, and U.S. Patent No. 5,930,700 to Pepper *et al.* ("Pepper").

For the reasons discussed above with respect to the rejection of claims 1-5, 7-8, 14-15, 24-28 and 32-34 over Nakatsu in view of Hayes-Roth, applicant respectfully requests withdrawal of the above rejections of claims 6, 9-13, 16-23, and 29-31.

### **CONCLUSION**

In view of the foregoing, applicant respectfully submits that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Daniel J. Goettle, at (215) 564-8974, to discuss resolution of any remaining issues.

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